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134

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/423,683 03/20/00 CAWTHORNE

M 00537/163002

EXAMINER

HM12/0328

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MOHAMED, A

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

03/28/01

8/10

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/423683

Applicant(s)

CAWTHORNE ET AL

Examiner

MOHAMED

Group Art Unit

1653

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/5/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-30 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2(1 page)
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 (1 page)
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other ATTACHMENT

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DETAILED ACTION

ACKNOWLEDGMENT OF PRIORITY, PRELIMINARY AMENDMENT, IDS, RESPONSE TO SEQUENCE REQUIREMENT, STATUS OF THE APPLICATION AND CLAIMS

1. This application is filed under 35 U.S.C. 371 on 3/20/00 having a filing date of 5/13/98 of PCT/EP98/02998, which is a Continuation of U.S. Patent Application No. 08/855,311, with a filing date 5/13/97, now abandoned. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file. The preliminary amendment, Information Disclosure Statement (IS) and Form PTO-1449 filed 3/20/00 and the response to sequence requirement filed 1/5/01, respectively are acknowledged, entered and considered. In view of Applicant's request claim 31 has been canceled. Thus, claims 1-30 are now pending in the application. With respect to the requirements of sequence listing, Applicant's argument is persuasive. In accordance with 37 C.F.R. § 1.822(b), the sequence disclosures on page 12 and also in the claims of the instant application contain one or more D-amino acid and therefore excluded from submitting sequence listing.

2. OBJECTION TO THE DISCLOSURE

The disclosure is objected to because of the following informalities: On page 5, line 9, in the recitation "(e.g., between 5 :g/day and 5 mg/day)" and on page 17, line 12 "light/dark cycles at 20 " 21C". Also, on page 12, the lines to form the structures are not clearly visible.

Appropriate correction is required.

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ABSTRACT MISSING

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

CLAIM OBJECTION-IMPROPER MULTIPLE DEPENDENT CLAIM

4. Claims 28 and 30 are objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and/or, cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). However, the claims have been treated on the merits.

STATEMENT OF STATUTORY BASIS, 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 29-30 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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CLAIMS REJECTION-35 U.S.C. § 112^{2nd} PARAGRAPH

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 6, 8-9, 12-14, 17-19, 22-26 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "somatostatin type-5 receptor selective agonist" in line 2.

There is insufficient antecedent basis for this limitation in claim 2 or claim 4.

Claim 6 recites the limitation "of lowering the amount of triacylglycerols....." in lines 2-7

3. There is insufficient antecedent basis for this limitation in claim 1 or claim 6.

Claims 23-26 are indefinite and confusing in the recitation "Tyr(I)" because the expression is not defined in the specification nor in the claim. Appropriate clarification is required.

Claims 29-30 provide for the use of the somatostatin type-5 receptor selective agonist product in the formulation of a pharmaceutical composition for treating hyperlipidemia in a human or mammalian animal, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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CLAIMS REJECTION-35 U.S.C. § 102(b)

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6-8, 10, 13-15, 18, 20 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Moller et al. (Clin. Science, Vol 75, pp. 345-350, 1988).

Moller et al. disclose the use of mixed SSTR-2/SSTR-5 agonist (e.g., SMS 201-995 or somatostatin-14) for the treatment of hyperlipidemia in which the reference clearly demonstrates the lowering of triglyceride levels (See e.g., page 348, Fig. 5) and blood glycerol levels (See e.g., Fig. 4). Thus, the reference clearly anticipates the method of treating hyperlipidemia by administering a therapeutically effective amount of a type-5 selective somatostatin agonist (SSTR-5 agonist) to a patient to reduce triglyceride and glycerol levels in the blood of said patient and to a pharmaceutical formulations thereof as claimed in claims 1,3, 6-8, 10, 13-15, 18, 20 and 27-29.

CLAIMS REJECTION-35 U.S.C. § 103(a)

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moller et al. (Clin. Science, Vol 75, pp. 345-350, 1988) in view of WO 96/35950 or Degrado (attachment).

The reference of Moller et al as discussed above under the rejection 102(b) discloses the use of mixed SSTR-2/SSTR-5 agonist (e.g., SMS 201-995 or somatostatin-14) for the treatment of hyperlipidemia. The primary reference differs from claims 1-30 in not teaching the use of highly selective SSTR-5 agonists (e.g., ratio SSTR-2/SSTR-5>2) and the modification of the peptide to include D-Phe and D-Trp. However, the reference of WO 96/35950 on page 17 Table II, discloses that the compound has a K of 7.0 nM for SSTR-5 receptor (ratio SSTR-2/SSTR-5 = 0.07). Thus, the prior art discloses several somatostatin analogues with the ratios as shown on Table II), hence, it appears to be obvious to one of ordinary skill in the art to test whether these or related compounds have any pharmaceutical effect on blood lipid levels.

Further, WO 96/35950 discloses Applicant's method using Applicant's claimed peptide Phe-Phe-Phe-Trp-Lys-Thr-Phe-Thr-NH₂, However, the reference does not teach modification of

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peptide to include D-Phe and D-Trp; but, this known modification of the peptide of WO 96/35590 would have been obvious to one of ordinary skill in the art because Degrado discloses that introduction of D-amino acids into a peptide is "a popular modification" that results in analogs with enhanced stabilities to enzymatic degradation. Thus, the combined teachings of the prior art makes obvious the claimed invention, absent of sufficient objective factual evidence or unexpected results to the contrary.


CONCLUSION AND FUTURE CORRESPONDENCE

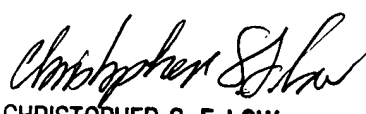
No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00.p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

 Mohamed/AAM
March 26, 2001


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
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